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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,199	11/16/1999	TAKANARI YAMAGUCHI	2185-0380P	3990

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EXAMINER
MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/441,199	YAMAGUCHI ET AL.
	Examiner	Art Unit
	Jeffrey C. Mullis	1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 May 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) *6-9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 10-12* is/are rejected.

7)☒ Claim(s) *5 and 13* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

All previous rejections are hereby withdrawn.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ota et al. (Translation of Japanese Patent 06-57008).

Ota et al. disclose a process for producing a resin composition in which components "A" and "B" are fed to an extruder which "melt kneads" and in which a component "C" is melt kneaded in a side feeder. Note the sentence bridging pages 13 and 14 of the translation. Note page 14 lines 6-9 where it is disclosed that the component "C" is supplied from the side feeder

(where it has been melt kneaded) to the "main body of the extruder from the side feeder". All three components are therefore melt kneaded in feeders prior to entering the extruder where all three components are melt kneaded together. Note also the first sentence of paragraph 20 on page 13 which discloses that the "extruder being used in the present invention is an extruder that is provided with two or more feeders such as a main feeder and side feeder and enables melt kneading". Therefore all components are melt kneaded prior to entering the extruder. Note Examples 1 and 6 which utilize thermoplastics and rubbers to form a composition.

Claims 2 and 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Translation of Ota et al., cited above.

With regard to claims 2 and 10, it is noted that these claims recite extrusion from a nozzle or particular length and melt index of a rubber. However upon careful reading of these claims, they only recite that the process is performed "at a temperature" where the rubber's viscosity on extrusion from a nozzle has a particular diameter or at a temperature where a particular melt index is inherent and given that viscosity and melt index are in fact a function of temperature itself, it would appear that the very broad range of temperatures could be used so long as the viscosity or melt index of the rubber was varied

according to the temperature. In any case the viscosity recited of 100-30,000 poise spans a factor of 300, an enormous range and it would therefore reasonably appear that the materials of the reference inherently possessed applicants' characteristic especially since the goal of both of applicants and that of the reference is to obtain good blends with little degradation.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

Choice of the particular temperature would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in that it requires only routine experimentation to find the optimum or workable range of a result effective variable absent any showing of surprising or unexpected results.

Claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ota et al., cited above in view of Fenton (USP 4,584,244).

Fenton discloses that elastomers are normally shipped and used as bales of rubber due to cold flow problems. Note column 1 lines 53-61.

It would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to use bales of rubber in the process of the primary reference as taught by Fenton in order to be able to utilize rubber as required by the primary reference but (as required in the primary reference) in the form normally as encountered and furthermore to minimize problems associated with cold flow absent any showing of surprising or unexpected results.

Claims 5 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants' remarks are moot since all previous rejections and/or objections have been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be

reached on (703) 308-2462. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cdc
September 24, 2003

Jeffrey Mullis
Primary Examiner
Art Unit 1711